

### REMARKS

Applicants thank the Examiner for total consideration given the present application. Claims 1-40 remain pending. Claims 1, 3, 10, 16, 20, and 29 are amended through this Reply. Claims 1, 10, 16, 20, and 29 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

### OBJECTION TO THE CLAIMS

Claims 1 and 3 stand objected to for minor informalities. *See Office Action, item 4, page 3.* Claims 1 and 3 have been amended to address this objection. Applicants respectfully request that the objection to the claims 1 and 3 be withdrawn.

### 35 U.S.C. § 112, 2<sup>ND</sup> PARAGRAPH REJECTION

Claims 9 and 15 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Initially, Applicants disagree with the Examiner's assertion that the term "renewable" renders the claims indefinite. Applicants respectfully submit that the Examiner's focus during examination for compliance with the requirement of definiteness in § 112, 2<sup>nd</sup> paragraph is whether the claim meets the threshold requirements of clarity and precision. To do this, the Examiner needs only ensure that the claims define the invention with a reasonable degree of particularity and distinctness. See MPEP § 2173.02.

The Office Action alleges that since a recording medium 5 is defined as a CD-R and that step 53 in Fig. 2 describes "the URL recorded on the recording medium 5 may be rewritten" in the specification, the term "renewable" is interpreted as a re-recording.

However, Applicants submit that the claims clearly define that the "renewal" does not define as re-recording of CD-R. Neither Fig. 2 or the written description of Figure 1 limits renewal as re-recording. The URL recorded on the recording medium does not necessitate re-recording of the URL information. The recording medium is recorded with updated URL information, which defines "renewal." Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

35 U.S.C. § 103 REJECTION – SHIOTA ET AL. IN VIEW OF MCINTYRE ET AL.

Claims 1, 2, 7-11, 13-17, 19-22, 25, 29-31, and 35-40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiota et al. (EP 0 856 972 A2) (hereinafter “Shiota”) in view of McIntyre et al. (U.S. Patent 7,016,868 B1) (hereinafter “McIntyre”). Applicants respectfully traverse.

For a Section 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P. 2142*; *M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, claim 1 recites “ An image print order system using a network, comprising: an order receiving server ... a terminal unit ... ***said order receiving server outputs print command data based on the received digital image data, and outputs command data so that a requester of a print order receives an image print that is printed based on said print command data, at a place that is selected by said requester from a list of print-order destinations.***” *Emphasis added.*

In contrast, Shiota merely teaches a system where a service center 2 accepts print order information via internet 5 from a customer 1 as shown in Figure 1. The accepted print order is forward to a laboratory server to process image data provided by the customer 1. Shiota specifically teaches that the center server 12, which is part of the service center 2, assigns the laboratory for outputting the print order. Shiota further teaches that the laboratory assignment is based on special equipments available at a specific laboratory to perform requested print order. However, Shiota fails to teach that “***said order receiving server outputs print command data based on the received digital image data, and outputs command data so that a requester of a print order receives an image print that is printed based on said print command data, at a place that is selected by said requester from a list of print-order destinations,***” as recited in claim 1.

In addition, McIntyre fails to teach or suggest the feature described above. Therefore, neither Shiota nor McIntyre alone, or in combination, teach or suggest all features in claim 1.

In regards to claim 10, which recites “A computer-readable medium on which digital image data has been recorded ... ***the print-order acceptor information designates an acceptor as a print-order destination selected from a list of print-order destinations ....***” ***Emphasis added.***

As discussed above, Shiota merely teaches assigning a laboratory server to process image data based on special equipments available at a specific laboratory to perform requested print order. However, Shiota fails to teach or suggest “***the print-order acceptor information designates an acceptor as a print-order destination selected from a list of print-order destinations,***” as recited in claim 10. In addition, McIntyre fails to teach or suggest the feature described above. Therefore, neither Shiota nor McIntyre alone, or in combination, teach or suggest all features in claim 10.

Similarly, claim 16 includes some of the features in claim 10 discussed above. Therefore, neither Shiota nor McIntyre alone, or in combination, teach or suggest all features in claims 10 and 16.

In regards to claim 20, which recites “An image print ordering system, comprising: one or more print service receiving servers connected to a network; ... a terminal configured to connect to the network ... ***information stored within the computer-readable medium includes connection address data of a selected print service receiving server among the one or more print service receiving servers, requested service shop data selected from a list of available service shops, and image data, ....***” ***Emphasis added.***

As discussed above, Shiota merely teaches assigning a laboratory server to process image data based on special equipments available at a specific laboratory to perform requested print order. However, Shiota fails to teach or suggest “***information stored within the computer-readable medium includes connection address data of a selected print service receiving server among the one or more print service receiving servers, requested service shop data selected from a list of available service shops, and image data,***” as recited in claim 20. In addition, McIntyre fails to teach or suggest the feature described above. Therefore, neither Shiota nor McIntyre alone, or in combination, teach or suggest all features in claim 20.

Similarly, claim 29 includes some of the features in claim 20 discussed above. Therefore, neither Shiota nor McIntyre alone, or in combination, teach or suggest all features in claims 20 and 29.

For at least these reasons, claims 1, 10, 16, 20, and 29 are distinguishable from the combination of Shiota and McIntyre. Claims 2, 7-9, 11, 13-15, 17, 19, 21, 22, 25, 28-31, and 35-40 depend from claims 1, 10, 16, 20, and 29. Therefore, for at least the reasons stated with respect to claims 1, 10, 16, 20, and, claims 2, 7-9, 11, 13-15, 17, 19, 21, 22, 25, 28-31, and 35-40 are also distinguishable over the combination of Shiota and McIntyre.

Applicants respectfully request that the rejection of claims 1, 2, 7-11, 13-17, 19-22, 25, 29-31, and 35-40, based on Shiota and McIntyre, be withdrawn.

35 U.S.C. § 103 REJECTION – SHIOTA AND MCINTYRE AND FURTHER IN VIEW OF ARLEDGE

Claims 3, 4, 7-9, 12-15, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiota and McIntyre and further in view of Arledge, Jr. et al. (U.S. Patent 6,535,294 B1) (hereinafter “Arledge”). Applicants respectfully traverse.

As presented above, Shiota and McIntyre fails to teach or suggest ***“said order receiving server outputs print command data based on the received digital image data, and outputs command data so that a requester of a print order receives an image print that is printed based on said print command data, at a place that is selected by said requester from a list of print-order destinations,”*** as recited in claim 1. Similarly, Shiota and McIntyre fails to teach or suggest ***“the print-order acceptor information designates an acceptor as a print-order destination selected from a list of print-order destinations,”*** as recited in claim 16. In addition, Arledge fails to teach or suggest the above limitation to supplement Shiota and McIntyre’s missing feature.

As set forth on page 14 of the Office Action, the Examiner relies on Arledge as allegedly pertaining to incremental features of the above listed dependent claims. The Examiner’s reliance on Arledge, however, fails to make up for the deficiencies of Shiota and McIntyre discussed above with respect to Claims 1, 10, and 16. Therefore, the asserted combination of Shiota,

McIntyre, and Arledge (assuming these references may be combined, which applicant does not admit) fails to establish *prima facie* obviousness of any pending claims.

35 U.S.C. § 103 REJECTION – SHIOTA, MCINTYRE, AND ARLEDGE AND FURTHER IN VIEW OF FANNING ET AL.

Claims 5-9 and 24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiota, McIntyre, and Arledge and in view of Fanning et al. (U.S. Patent 6,742,023 B1) (hereinafter “Fanning”). Applicants respectfully traverse.

As presented above, Shiota, McIntyre, and Arledge fails to teach or suggest “*said order receiving server outputs print command data based on the received digital image data, and outputs command data so that a requester of a print order receives an image print that is printed based on said print command data, at a place that is selected by said requester from a list of print-order destinations,*” as recited in claim 1. Similarly, Shiota and McIntyre fails to teach or suggest “*information stored within the computer-readable medium includes connection address data of a selected print service receiving server among the one or more print service receiving servers, requested service shop data selected from a list of available service shops, and image data,*” as recited in claim 20. In addition, Fanning fails to teach or suggest the above limitation to supplement Shiota, McIntyre, and Arledge’s missing feature.

As set forth on page 16 of the Office Action, the Examiner relies on Fanning as allegedly pertaining to incremental features of the above listed dependent claims. The Examiner’s reliance on Fanning, however, fails to make up for the deficiencies of Shiota, McIntyre, and Arledge discussed above with respect to Claims 1 and 20. Therefore, the asserted combination of Shiota, McIntyre, Arledge, and Fanning (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of any pending claims.

35 U.S.C. § 103 REJECTION – SHIOTA AND MCINTYRE AND FURTHER IN VIEW OF FANNING

Claims 23 and 32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiota and McIntyre and further in view of Fanning. Applicants respectfully traverse.

As presented above, Shiota and McIntyre fails to teach or suggest ***“information stored within the computer-readable medium includes connection address data of a selected print service receiving server among the one or more print service receiving servers, requested service shop data selected from a list of available service shops, and image data,”*** as recited in claim 20. Similarly, claim 29 includes some of the features in claim 20. In addition, Fanning fails to teach or suggest the above limitation to supplement Shiota and McIntyre’s missing feature.

As set forth on page 18 of the Office Action, the Examiner relies on Fanning as allegedly pertaining to incremental features of the above listed dependent claims. The Examiner’s reliance on Fanning, however, fails to make up for the deficiencies of Shiota and McIntyre discussed above with respect to Claims 20 and 29. Therefore, the asserted combination of Shiota, McIntyre, and Fanning (assuming these references may be combined, which Applicants do not admit) fails to establish *prima facie* obviousness of any pending claims.

35 U.S.C. § 103 REJECTION – SHIOTA AND MCINTYRE AND FURTHER IN VIEW OF HURTADO ET AL.

Claims 26-28, 33, and 34 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiota and McIntyre and further in view of Hurtado et al. (U.S. Patent 6,611,812 B2) (hereinafter “Hurtado”). Applicants respectfully traverse.

As presented above, Shiota and McIntyre fails to teach or suggest ***“information stored within the computer-readable medium includes connection address data of a selected print service receiving server among the one or more print service receiving servers, requested service shop data selected from a list of available service shops, and image data,”*** as recited in claim 20. In addition, Hurtado fails to teach or suggest the above limitation to supplement Shiota and McIntyre’s missing feature.

As set forth on page 19 of the Office Action, the Examiner relies on Hurtado as allegedly pertaining to incremental features of the above listed dependent claims. The Examiner's reliance on Hurtado, however, fails to make up for the deficiencies of Shiota and McIntyre discussed above with respect to Claim 20. Therefore, the asserted combination of Shiota, McIntyre, and Hurtado (assuming these references may be combined, which applicant does not admit) fails to establish *prima facie* obviousness of any pending claims.

Conclusion

In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact D. Richard Anderson, Reg. No. 40,439 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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